

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN E. KULAKOWSKI
and
RODNEY J. MEANS

Appeal No. 1999-0162
Application No. 08/414,248

ON BRIEF

Before RUGGIERO, BLANKENSHIP, and KRASS, Administrative Patent Judges.

RUGGIERO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal from the final rejection of claims 16-20 and 24-45. Claims 1-15 and 21-23 were canceled earlier in the prosecution and claims 46-48 were withdrawn from consideration as being directed to a non-elected invention. An amendment after final rejection filed July 3, 1997, which canceled claims 16-20, 24, 25, and 46-48,

was entered by the Examiner. Accordingly, only the final rejection of claims 26-45 is before us on appeal.

The claimed invention relates to a method for operating a library of multi-disk cartridges, the library including multiple disk drives and a cartridge picker. The cartridge picker operates to exchange multi-disk cartridges between disk drives. Each disk drive includes a disk picker for exchanging selected disks with a selected multi-disk cartridge.

Claim 26 is illustrative of the invention and reads as follows:

26. A method for operating a library of multi-disk cartridges, said library including multiple disk drives and a cartridge picker to exchange multi-disk cartridges between the disk drives, each disk drive including a respective disk picker, said method comprising:

- a first step of operating the cartridge picker to load a first multi-disk cartridge in a first one of the disk drives;
- a second step of operating a first disk picker in the first disk drive to exchange a first selected disk with the first multi-disk cartridge;
- a third step of operating the cartridge picker to unload the first multi-disk cartridge from the first disk drive;
- a fourth step of operating the cartridge picker

Appeal No. 1999-0162
Application No. 08/414,248

to load the first multi-disk cartridge in a
second one of the disk drives; and

a fifth step of operating a second disk picker
in the second disk drive to exchange a
second selected disk with the first multi-
disk cartridge.

Appeal No. 1999-0162
Application No. 08/414,248

The Examiner relies on the following prior art:

Rudy et al. (Rudy)	4,685,095	Aug. 04, 1987
Takemasa et al. (Takemasa)	5,014,258	May 07, 1991
Motoyoshi et al. (Motoyoshi)	5,022,019	Jun. 04, 1991
Ishibashi et al. (Ishibashi)	5,107,474	Apr. 21, 1992
Lee	5,434,833	Jul. 18, 1995

(filed Jul. 06, 1993)

Claims 26-45 stand finally rejected under 35 U.S.C.

§ 103. As evidence of obviousness, the Examiner offers Motoyoshi in view of Ishibashi with respect to claims 26-41 and 44, adds Lee to the basic combination with respect to claim 42, adds Rudy to the basic combination with respect to claim 43, and adds Takemasa to the basic combination with respect to claim 45.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief (Paper No. 15) and Answer (Paper No. 16) for the respective details.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the Examiner, and the

Appeal No. 1999-0162
Application No. 08/414,248

evidence of obviousness relied upon by the Examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, Appellants' arguments set forth in the Brief along with the Examiner's rationale in support of the rejections and arguments in rebuttal set forth in the Examiner's Answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would not have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 26-45. Accordingly, we reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led

Appeal No. 1999-0162
Application No. 08/414,248

to

modify the prior art or to combine prior art references to
arrive

at the claimed invention. Such reason must stem from some
teaching, suggestion, or implication in the prior art as a
whole

or knowledge generally available to one having ordinary skill
in

the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,
1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S.
825

(1988); Ashland Oil, Inc. v. Delta Resins & Refractories,
Inc.,

776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert.
denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v.

Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed.
Cir. 1984). These showings by the Examiner are an essential
part of complying with the burden of presenting a prima facie
case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445,
24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to claims 26-41 and 44, the Examiner, as the

basis for the obviousness rejection, proposes to modify the disk storage device of Motoyoshi. According to the Examiner (Answer, page 4), Motoyoshi discloses the claimed invention except for the exchanging of multi-disk cartridges in general as well as any disclosure of the exchange of disks from one multi-disk cartridge to another. To address these deficiencies, the Examiner turns to Ishibashi which describes a multi-magazine disk player which selectively accesses disks from an array of multi-disk cartridges. In the Examiner's view, the skilled artisan would have been motivated and found it obvious to utilize multi-disk cartridges, as suggested by Ishibashi, instead of single disk cartridges in Motoyoshi, thereby providing easier removal and handling. The Examiner further suggests that the skilled artisan would have appreciated that the routine swapping of disks by

Appeal No. 1999-0162
Application No. 08/414,248

removal from one cartridge and insertion into another was "notoriously old and well known in the information processing art." (Answer, page 6).

In response, Appellants assert several arguments in support of their position that the Examiner has not established proper motivation for the proposed combination of references so as to set forth a prima facie case of obviousness. After careful review of the applied prior art in light of the arguments of record, we are in agreement with Appellants' position as stated in the Brief.

Initially, we agree with Appellants' contention (Brief, page 11) that the Examiner's assertion that Appellants' claimed disk exchanging limitations are standard manipulations for multi-disk cartridge disk drives is devoid of any supporting evidence on the record. We are not inclined to dispense with proof by evidence when the proposition at issue is not supported by a teaching in a prior art reference, common knowledge or capable of unquestionable demonstration. Precedents of our reviewing court require this evidence in order to establish a prima facie case. In re Knapp-Monarch Co., 296 F.2d 230, 232, 132

Appeal No. 1999-0162
Application No. 08/414,248

USPQ 6, 8 (CCPA 1961); In re Cofer, 354 F.2d 664, 668, 148
USPQ 268, 271-72 (CCPA 1966).

Further, it is our opinion that, notwithstanding the merits of the Examiner's generalized assertion that multi-disk cartridge exchange manipulations are well known, such assertion does not address the issue of obviousness with respect to the appealed claims. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992). After reviewing the Motoyoshi and Ishibashi references, we find no motivation for the skilled artisan to apply the multi-disk cartridge teaching of Ishibashi to the disk storage system of Motoyoshi. There is nothing in the disclosure of Motoyoshi to indicate that the alignment of a single playback device with a single multi-disk cartridge from an array of cartridges, the problem addressed by Ishibashi, was ever a concern. It is our opinion that the only basis for applying the teachings of Ishibashi to the structure of Motoyoshi comes from an improper attempt to reconstruct

Appeal No. 1999-0162
Application No. 08/414,248

Appellants' invention in hindsight.

We are further of the view that even assuming, arguendo, that proper motivation were established for the Examiner's proposed combination, the resulting system would fall far short of meeting the specific requirements of the claims on appeal. Independent claim 26 sets forth a series of method steps reciting a specific interrelationship of multi-disk cartridges, a cartridge picker, and disk pickers to effect a multi-disk cartridge exchange. The Examiner has provided no indication as to how and where the skilled artisan might have found it obvious to modify either of Motoyoshi or Ishibashi to arrive at the specifics of the claimed invention.

Also, we agree with Appellants (Brief, page 18) that neither Motoyoshi nor Ishibashi addresses inter-drive cartridge swapping, a key requirement of independent claim 26. In order for us to sustain the Examiner's rejection under 35 U.S.C. § 103, we would need to resort to speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968), reh'g denied, 390 U.S. 1000

Appeal No. 1999-0162
Application No. 08/414,248

(1968). Accordingly, since the Examiner has not established a prima facie case of obviousness, the rejection of independent claim 26, and claims 27-41 and 44 dependent thereon, over the combination of Motoyoshi and Ishibashi is not sustained.

Appeal No. 1999-0162
Application No. 08/414,248

Turning to a consideration of the Examiner's 35 U.S.C. § 103 rejections of dependent claims 42, 43, and 45 in which the Lee, Rudy, and Takemasa references are individually added, respectively, to the combination of Motoyoshi and Ishibashi, we do not sustain these rejections as well. It is apparent from the Examiner's analysis (Answer, pages 7-10) that the Lee, Rudy, and Takemasa references are relied on solely to address the locking, alignment, and orientation features of dependent claims 42, 43, and 45. We find nothing, however, in the disclosures of Lee, Rudy, or Takemasa, individually or collectively, which would overcome the innate deficiencies of Motoyoshi and Ishibashi discussed supra.

Appeal No. 1999-0162
Application No. 08/414,248

In conclusion, since the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. § 103 rejection of independent claim 26 and claims 27-45 dependent thereon, cannot be sustained. Therefore, the decision of the Examiner rejecting claims 26-45 is reversed.

REVERSED

ERROL A. KRASS)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
JOSEPH F. RUGGIERO)	APPEALS AND
Administrative Patent Judge)	INTERFERENCES
)	
)	
)	
HOWARD B. BLANKENSHIP)	
Administrative Patent Judge)	

JFR:hh

Appeal No. 1999-0162
Application No. 08/414,248

TERRANCE A. MEADOR
GRAY, CARY, WARE & FREIDENRICH
401 B STREET, SUITE 1700
SAN DIEGO, CA 92101